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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,177	03/15/2000	Takashi Munakata	44084-443	9237

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WASHINGTON, DC 20005-3096

EXAMINER

TRAN, DOUGLAS Q

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 06/03/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/526,177

Applicant(s)

MUNAKATA ET AL.

Examiner

Douglas Q. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6 and 7 is/are rejected.
- 7) ☒ Claim(s) 7,8,10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/15/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

3. Claims 9-10 are objected to because of the following informalities:
for claim 9, line 3 on page 19: "apparatus" would be "apparatuses"; line 4 on page 19: "tray" from "one of said paper ejection tray" would be "trays" .
for claim 10, line 3 on claim 10: "trays" would be "tray".
Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 6 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Mandel et al. (US Patent No. 5,823,529).

As to claim 6, Mandel discloses an image forming apparatus (i.e., electronic printer 14 in fig. 6) capable of being connected to a plurality of external apparatuses (15 in fig. 6) and performing image formations based on data sent from the external apparatuses (col. 31, lines 30-33 describes that trays for receiving recording sheets on which images are formed “discharged” from inside of the printer; the sheets at these trays are already printed with images from the print jobs “col. 2, lines 34-37”), said image forming apparatus comprising:

a plurality of paper ejection trays (figure 5 shows the printer having a mailbox system includes the mailbox bins or trays 11, 116, 23 in fig. 5, col. 12, lines 46-49) for receiving sheets on which images are formed (col. 31, lines 30-33 describes that trays for receiving recording sheets on which images are formed “discharged”); and

notification means (i.e., a controller 100 in fig. 5) for notifying a user of a specific one of the paper ejection trays in which a last ejected sheet is present (col. 29, lines 22-34: the user send the print job to the “almost-full” bin of the printer, the print job is separated into two parts, the first part is delivered to the “almost-full” bin until the bin is full, then the rest of that print job is delivered onto newly assigned bin 11. It is noted that the rest of that print job would be at least one of the last sheets. The user is informed of that automatically through a message “col. 29, lines 33-34”. Therefore, the user would be notified his print job locates on two different bins including the last assigned bin storing the last part of the print job. The printer inherently comprises a component corresponding to notification means for generating a message to the user of the status of his print job stored in the specified trays, or the notification means would be a

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controller “100 in the mailbox system in fig. 5” because there only is a controller in this mailbox system for generating a display instructional signal to the terminal 15 of the assigned user “col. 29, lines 4-9”. Thus, the controller 100 would also notify the status of the assigned user’s print job at the printer trays).

As to claim 9, Mandel discloses an image forming apparatus (i.e., electronic printer 14 in fig. 6) capable of being connected to a plurality of external apparatuses (15 in fig. 6) and performing image formations based on data sent from the external apparatuses (col. 31, lines 30-33 describes that trays for receiving recording sheets on which images are formed “discharged” from inside of the printer; the sheets at these trays are already printed with images from the print jobs “col. 2, lines 34-37”), said image forming apparatus comprising:

a plurality of paper ejection trays (figure 5 shows the printer having a mailbox system includes the mailbox bins or trays 11, 116, 23 in fig. 5, col. 12, lines 46-49) for receiving sheets on which images are formed (col. 31, lines 30-33 describes that trays for receiving recording sheets on which images are formed “i.e., discharged”);

a control unit (i.e., a controller 100 in fig. 5) for, when the number of sheets required to execute an ejection instruction from one of the external apparatus exceeds a capacity of one of said paper ejection trays, ejecting a part of sheets to one of said paper ejection trays and continuously ejecting the remaining sheets to another paper ejection tray (col. 29, lines 22-33: the user requests for sending the print job to the assigned bin which is “almost-full” even he knows, the print job is separated into two parts, the first part is delivered to the “almost-full” bin until the bin is full, then the rest of that print job is delivered onto newly assigned bin 11. The

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controller 100 would eject the remaining sheets to another paper ejection tray, with respect to col. 28, lines 64-67, because the controller 100 will normally know into which bin further sheets will be directed by the sheet distribution system of the mailbox system, the carriage can be moved to that next bin to be user and, col. 30, lines 22-26, the controller 100 for controlling the entire of operation of the mailbox module unit 10); and

notifying means (i.e., a controller 100 in fig. 5) for notifying a user of the paper ejection trays where the part of sheets and the remaining sheets are present (col. 29, lines 22-34 describes that after the user's the print job is separated into two parts which are delivered onto two different trays, the user is informed of that automatically through a message "col. 29, lines 33-34". Therefore, the user would be notified his print job locates on two different bins including the last assigned bin storing the last part of the print job. The printer inherently comprises a component corresponding to notification means for generating a message to the user of the status of his print job stored in the specified trays, or the notification means would be a controller "100 in the mailbox system in fig. 5" because there only is a controller in this mailbox system for generating a display instructional signal to the terminal 15 of the assigned user "col. 29, lines 4-9". Thus, the controller 100 would also notify the status of the assigned user's print job at the printer trays).

Allowable Subject Matter

6. Claims 1-5 are allowed.

Claim 1 is independent claim.

The following is an examiner's statement of reasons for allowance:

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7. As to claim 1, the closest prior art such as Mandel et al. (US Patent No. 5,823,529) discloses the controller 100 for notifying an assigned user that the sheets are ejected to a plurality of mailbox bins. However, Mandel, including an updated electronic text search, would not teach "a plurality of notifying units respectively disposed on the paper ejection trays or in the vicinity of the paper ejection trays, the notifying units being for notifying a user that the sheets are ejected to a plurality of paper ejection trays in response to at least one ejection instruction from the same external apparatus are present".

8. Claims 7-8 and 10 are objected.

Claims 7 and 10 are objected to as being dependent upon a rejected base claims 6 and 9 respectively, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for objecting:

As to claim 7, the prior art, taken either singly or in combination, does not teach: the notifying means comprises a plurality of notifying units respectively corresponding to the paper ejection trays; and a controller, connected with the notifying units, for controlling the notifying units.

As to claim 10, the prior art, taken either singly or in combination, does not teach: the notifying means includes a plurality of display units respectively provided in corresponding with each paper ejection tray.

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Examiner's Remarks

Desmond et al. (U.S. Patent No. 5,991,516) discloses the printer is supplied with a burst whenever a burst is available without regard for job or document boundaries.

Watanabe et al. (U.S. Patent No. 6,456,386 B1) discloses a printer capable of easily detecting a unit, which has issued appointment of recording sheets received in the bins in the sorter.

Nishiwaki (U.S. Patent No. RE37,031 E) discloses a printer accepting print requests from users comprising bins storing printout and locks each locking a corresponding one of bins, wherein the printer locks one of the bins and delivers the printouts to that one of the bins.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
May 28, 2003

A handwritten signature in black ink, appearing to read "Douglas Q. Tran", with a long horizontal stroke extending to the right.